

Remarks

Claims 1, 5-11 and 15-19 are pending in the application. Claims 2-4 and 12-14 have been canceled without prejudice or disclaimer.

Claim rejections

Section 112

Claims 1-19 were rejected under 35 USC 112, 1st paragraph as failing to comply with the written description requirement. The Applicant respectfully traverses. The claims are supported as indicated below (for convenience, the following refers to parent patent 6,748,209).

Apparatus comprising a processor, memory storing instructions, and a communication interface: FIG. 1, CPU 104, memory 106, serial interface 150; col. 3, line 47 to col. 4, line 36.

Instructions to generate a graphical interface, etc.: col. 3, lines 51-56, col. 5, lines 46-53.

Graphical interface displays a different image (telephone type) in response to a user input: col. 6, lines 13-30.

Graphical interface includes a field to receive a user input to initiate programming: FIG. 4, field 410; col. 6, lines 51-53.

Graphical interface includes a field to display an electronic serial number: FIG. 4, field 416; col. 7, lines 3-5.

Graphical interface is displayed on a display monitor: FIG. 1, display monitor 110; col. 5, lines 51-53.

Input value relates to an activation parameter: col. 6, lines 31-61.

Activation parameter identifies a cellular service provider: col. 6, lines 35-42.

Instructions to implement the invention are stored on a machine-readable medium: col. 3, line 59 to col. 4, line 3.

In view of the above, the written description requirement is fully met. Withdrawal of the rejection is therefore respectfully requested.

Claims 11-19 were rejected under 35 USC 112, 1st paragraph as failing to comply with the enablement requirement. The Applicant respectfully traverses. As stated in the MPEP § 2161.01(III), “[w]hen basing a rejection on the failure of the applicant's disclosure to meet the enablement provisions of the first paragraph of 35 USC 112, USPTO personnel must establish on the record a reasonable basis for questioning the adequacy of the disclosure to enable a person of ordinary skill in the art to make and use the claimed invention without resorting to *undue experimentation*. See *In re Brown*, 477 F.2d 946, 177 USPQ 691 (CCPA 1973); *In re Ghiron*, 442 F.2d 985, 169 USPQ 723 (CCPA 1971)” (emphasis in original). In this case, the Office Action merely concludes, after observing that the disclosure includes block diagrams and flowcharts but not specific program instructions, that “more than routine experimentation would be required of one skilled in the art to generate such a program ... ” (Office Action, page 5, ines 14-16). However, as observed in the Office Action, “[i]n order to meet his or her burden of establishing a reasonable basis for questioning the adequacy of such disclosure, the examiner should initiate a factual analysis of the system by focusing on each of the individual block element components” (MPEP § 2164.06(c)). The Office Action does not provide any such focused analysis, and accordingly, the Applicant respectfully submits that the burden is not met. Withdrawal of the rejection is therefore respectfully requested.

Claims 1-10 were rejected under 35 USC 112, 2nd paragraph as being indefinite. The Applicant respectfully traverses.

The Office Action cites *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990) as support for the proposition that “[a] single claim which claims both an apparatus and a process of using the apparatus is indefinite under 35 USC 112, second paragraph.” However, claims 1-10 do not recite an apparatus and process for using it; they only recite an apparatus and elements thereof. Therefore, *Ex parte Lyell* is not relevant. Withdrawal of the rejection is therefore respectfully requested.

Section 101

Claims 1-10 were rejected under 35 USC 101 as allegedly being directed to non-statutory subject matter. The Applicant respectfully traverses. Along lines discussed above, the claims recite an apparatus and elements thereof, which is statutory subject matter. Withdrawal of the rejection is respectfully requested.

Section 102

Claims 1-19 were rejected under 35 USC 102(e) as being anticipated by McGregor et al. (US 5,625,669) ("McGregor"). The Applicant respectfully traverses. McGregor does not support the rejection for at least the reason that McGregor does not disclose "in response to a first user input value specifying a first cellular telephone type, the graphical user interface is to display a first image corresponding to the first cellular telephone type, and in response to a second user input value modifying the first user input value to specify a second cellular telephone type different from the first, the graphical user interface is to display a second image different from the first image, the second image corresponding to the second cellular telephone type" as recited in independent claims 1 and 11. Claims 1 and 11 are therefore allowable over McGregor, as are the dependent claims for at least the foregoing reasons. Withdrawal of the rejection is therefore respectfully requested.

Double patenting

Claims 1-19 were further rejected on the grounds of non-statutory obviousness-type double patenting as being unpatentable over the claims of US patents 5,974,311 and 6,748,209. A terminal disclaimer to overcome the rejection is submitted herewith.


Conclusion

In light of the above discussion, Applicant respectfully submits that the present application is in all aspects in allowable condition, and earnestly solicits favorable reconsideration and early issuance of a Notice of Allowance.

The Examiner is invited to contact the undersigned at (202) 220-4323 to discuss any matter concerning this application. The Office is authorized to charge any fees related to this communication to Deposit Account No. 11-0600.

Respectfully submitted,

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By: 
William E. Curry
Reg. No. 43,572

KENYON & KENYON LLP
1500 K Street, N.W., Suite 700
Washington, D.C. 20005
Tel: (202) 220-4200
Fax: (202) 220-4201